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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/046,952 | 01/15/2002 | William Kress Bodin | AUS920010851US1 | 4415 |

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| EXAMINER |
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MARTIN, NICHOLAS A

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| ART UNIT | PAPER NUMBER |
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2154

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/046,952

Applicant(s)

BODIN ET AL.

Examiner

Nicholas Martin

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4/22/02, 5/22/02</u> . | 6) <input type="checkbox"/> Other: _____ |

1. Claims 1-21 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-3, 8-10 and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated over Tobita et al. (hereinafter Tobita), US 2002/0009987.
4. As per claim 1, Tobita teaches a method of email administration comprising the steps of:

receiving in a transcoding gateway from a sender an email display capability request, wherein the request comprises a domain identification (Paragraphs [0011-0013] and [0020]);

finding at least one email display capability record, wherein the email display capability record comprises display capability attributes describing an email display capability for the domain (Paragraphs [0011-0012]); and

sending at least one of the email display capability attributes to the sender (Paragraphs [0011], [0013] and [0020]).

5. As per claim 2, Tobita teaches the method of claim 1 wherein the email display capability request includes a sender identification identifying the sender, and the method further comprises determining, in dependence upon the sender identification, that the sender is authorized to send email to a connection address in the domain (Paragraphs [0012], [0014], [0017-0018] and [0020]).

6. As per claim 3, Tobita teaches the method of claim 2 wherein determining that the sender is authorized to send email to a connection address in the domain further comprises finding, in dependence upon the sender identification and in dependence upon the domain identification, at least one sender authorization record (Paragraphs [0012], [0014], [0017-0018] and [0020]), wherein:

the sender authorization record represents authorization for the sender to send email to a connection address in the domain (Paragraphs [0012], [0014], [0017-0018], [0020] and [0030]);

the sender authorization record comprises sender authorization attributes including a connection address in the domain (Paragraphs [0137-0138]); and

finding at least one email display capability record for the domain further comprises finding, in dependence upon the domain identification and in dependence

upon the connection address, at least on email display capability record for the domain (Paragraphs [0011-0014], [0017-0018] and [0020]).

7. Claims 8-10 do not teach or define any new limitations above claims 1-3 and therefore are rejected for similar reasons.

8. As per claim 15, Tobita teaches a computer program product of email administration comprising:

a recording medium (Paragraphs [0096-0097]);

means, recorded on the recording medium, for receiving in a transcoding gateway from a sender an email display capability request for a domain, wherein the capability request comprises a domain identification (Paragraphs [0011-0013], [0020] and [0096-0097]);

means, recorded on the recording medium, for finding, in dependence upon the domain identification, at least one email display capability record for the domain, wherein the email display capability record for the domain comprises display capability attributes describing an email display capability for the domain (Paragraphs [0011-0012], [0020] and [0096-0097]); and

means, recorded on the recording medium, for sending at least one of the email display capability attributes to the sender (Paragraphs [0011], [0013], [0020] and [0096-0097]).

9. Claims 16-17 do not teach or define any new limitations above claims 2-3 and therefore are rejected for similar reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4-7, 11-14 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tobita et al. (hereinafter Tobita), US 2002/0009987, in view of Furukawa et al. (hereinafter Furukawa), US 2002/0009073.

11. As per claim 4, Tobita teaches the method of claim 1 further comprising the steps of:

receiving an email in a transcoding gateway, the email comprising an email address (Paragraphs [0011-0013], [0020] and [0030]);

determining, in dependence upon display capability attributes and the email address, transcoded in the transcoding gateway (Paragraphs [0011-0013] and [0020]);

forwarding the email to the email address, if the determination is not to be transcoded in the transcoding gateway (Paragraphs [0020], [0034] and [0127]; Pages 10-11, claim 5); and

if the determination is that the object is to be transcoded in the transcoding gateway, carrying out the further steps of:

transcoding the object into a transcoded object (Paragraphs [0012], [0022] and [0042]); and

downloading the transcoded object to a destination client device
(Paragraphs [0011] and [0047]).

12. Tobita does not teach the method comprising the email message comprising at least one digital object.

13. Furukawa teaches the method comprising the email message comprising at least one digital object (Paragraphs [0051] and [0057]).

14. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Furukawa and Tobita because they both deal with transferring data over a network involving a communication connection. Furthermore, the teaching of Furukawa to allow the method comprising the email message comprising at least one digital object would improve functionality of Tobita's system by allowing for digital data to also be transferred between terminals, which increases the system's versatility in dealing with transmission of data.

15. As per claim 5, Tobita teaches the method of claim 4 wherein:

transcoding the object further comprises transcoding the object into a file having a file name (Paragraphs [0012], [0022], [0042] [0083] and [0086]); and

downloading the transcoded object further comprise downloading the file into a destination client device at an internet address recorded in an internet address field of a client device record (Paragraphs [0011] and [0047]), the client device record having:

recorded in a mailbox address field in the client device record, a mailbox address identical to the email address of the email message (Paragraphs [0085-0089]).

16. Tobita does not teach the method of claim 4 wherein:

the object is a digital object;

recorded in a digital file format code filed of the client device record, a digital file format code indicating that the client device represented by the client device record is capable of receiving the digital format of the digital file.

17. Furukawa teaches the method wherein:

the object is a digital object (Paragraphs [0051] and [0057]);

recorded in a digital file format code filed of the client device record, a digital file format code indicating that the client device represented by the client device record is capable of receiving the digital format of the digital file (Paragraphs [0022], [0051], [0057], [0507] and [0794]).

18. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Furukawa and Tobita because they both deal with transferring data over a network involving a communication connection. Furthermore, the teaching of Furukawa to allow wherein the object is a digital object and recorded in a digital file format code filed of the client device record, a digital file format code indicating that the client device represented by the client device record is capable of receiving the digital format of the digital file would improve functionality of Tobita's system by allowing for digital data to also be transferred between terminals, which increases the system's versatility in dealing with transmission of data.

19. As per claim 6, Tobita teaches the method of claim 4 wherein determining, in dependence upon display attributes and the email address, whether the object is to be transcoded in the transcoding gateway, further comprises finding a capability record

having an address equal to the email address (Paragraphs [0011-0013], [0030] and [0085-0089]).

20. Tobita does not teach the method of claim 4 wherein:

the object is a digital object;

a record having a connection address.

21. Furukawa teaches the method of claim 4 wherein:

the object is a digital object (Paragraphs [0051] and [0057]);

a record having a connection address (Paragraph [1039]).

22. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Furukawa and Tobita because they both deal with transferring data over a network involving a communication connection. Furthermore, the teaching of Furukawa to allow wherein the object is a digital object and a record having a connection address would improve functionality of Tobita's system by allowing for digital data to also be transferred between terminals and to notify/record transmission of said data for future reference/transmission/communication.

23. As per claim 7, Tobita teaches the method of claim 4 wherein forwarding the email further comprises forwarding the email to an email client (Paragraphs [0034] and [0127]; Pages 10-11, claim 5).

24. Tobita does not teach the method of claim 4, wherein forwarding includes the digital object to another gateway in a client device.

25. Furukawa teaches the method of claim 4, wherein forwarding includes the digital object to another gateway in a client device (Paragraphs [0051], [0057] and [1117]).

26. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Furukawa and Tobita because they both deal with transferring data over a network involving a communication connection. Furthermore, the teaching of Furukawa to allow wherein forwarding includes the digital object to another gateway in a client device would improve functionality of Tobita's system by allowing for digital data to also be transferred between terminals and through additional clients/users.

27. Claims 11-14 do not teach or define any new limitations above claims 4-7 and therefore are rejected for similar reasons.

28. Claims 18-21 do not teach or define any new limitations above claims 4-7 and therefore are rejected for similar reasons.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents and publications are cited to further show the state of the art with respect to "Dynamic Indication Of Email Capabilities".

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|------|-----------------|-----------------|
| i. | US 6,101,320 | Schuetze et al. |
| ii. | US 2002/0032725 | Araujo et al. |
| iii. | US 6,661,798 | Sano et al. |
| iv. | US 2002/0147780 | Liu et al. |

Art Unit: 2154

A shortened statutory period for reply to this Office action is set to expire in THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Martin whose telephone number is (571) 272-3970. The examiner can normally be reached on Monday - Friday 8:30 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3970.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

nam
February 3, 2005



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